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On

11/4/05

By: Conrad O. Gardner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No.: 2005-1094

Application No. 08/896,514

Applicant: Conrad O. Gardner

**For: EXTENDED RANGE MOTOR VEHICLE HAVING AMBIENT
POLLUTION PROCESSING**

REINSTATEMENT OF APPEAL BRIEF

Sir:

This is an appeal from the final rejection of the examiner on Remand by the Board of Appeals to consider the new rejection of claims 55 and 59 under 35 USC 103 as being unpatentable over Lynch (U.S. patent 4,165,795) in view of nickel cadmium batteries known in the art and comprising "fast charge-discharge" batteries.

I

**THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE
CASE OF OBVIOUSNESS**

To establish a prima facie case of obviousness three criteria must be met. First, there must be some suggestion or motivation in the references themselves to modify the reference or make the combined teachings. In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir.1991).

The final rejection is in error since relying on the following battery specification (col.5, lines 13-20) from Lynch for motivation to use fast charge-discharge batteries such as nickel cadmium batteries in Lynch:

“ Although the motor-generator may use most any voltage, it has been found that using two parallel sets of six (12volt) batteries (72volts) is satisfactory. The batteries should be designed for short duration, **high current discharge** and have a low internal resistance. This can be achieved by using standard automotive starting batteries with a large number of thin plates.”

Standard automotive starting batteries having the above defined characteristics for cranking an engine are **not** “fast charge-discharge batteries” as defined in the specification and used in claims 55 and 59. (See page 12, beginning at line 6 of the DECISION ON APPEAL where the Board interpreted “fast charge-discharge” battery as used in the appellants claims 55 and 59 as a battery capable of faster charge than the current lead acid batteries.” As a consequence, there is **no evidence or motivation** as to why batteries capable of faster charge than the current lead acid batteries would be used in Lynch. As such, the examiners position is not well taken.

II

SINCE THE EXAMINER BEARS THE INITIAL BURDEN OF FACTUALLY SUPPORTING A PRIMA FACIE CONCLUSION OF OBVIOUSNESS AND HAS NOT PRODUCED A PRIMA FACIE CASE, THE APPLICANT IS UNDER NO OBLIGATION TO SUBMIT EVIDENCE OF NONOBVIOUSNESS

III

EVIDENCE OF NONOBVIOUSNESS OF SUBSTITUTING NICKEL CADMIUM BATTERIES FOR LEAD ACID BATTERIES IN THE SYSTEM OF LYNCH IS CLEARLY PROVEN BY THE AFFIDAVIT OF PHILIP C. MALTE

The “**DETAILED ACTION**” presented by the examiner on page 3 concerns the Rule 132 Affidavit of Philip C. Malte wherein all the factual evidence is repeated and accepted, only the conclusion being refuted.

It is admitted that fast charge-discharge batteries were known at the time of the invention. It is also clear from the Rule 132 Affidavit that such batteries were not only not used in automobiles, though known, but were actually avoided for reasons stated in the Affidavit and repeated by the examiner beginning at page 3, lines 7 and following. This fact specifically teaches away from the examiner’s position that it would have been obvious to substitute for the lead acid battery. In summation, the fast charge-discharge battery was known at the time of the invention and rejected at that time for use in automotive environments. It follows that not only is there no teaching to combine such battery in an automotive system, but, on the other hand, the prior art teaches away from such a combination. In this regard, reference is made to In re Moore, 170 USPQ 260 (included in Appendix A), a CCPA decision whose decisions have been adopted by the CAFC

IV

CLAIMS 55 AND 59 CLEARLY ALLOWABLE

Claims 55 and 59 are clearly allowable for the reasons given above.

Further, claim 55 defines a robust electric-drive battery recharging system. In fact, see the Affidavit of Philip C. Malte in applicants SECOND SUPPLEMENTAL BRIEF ON APPEAL at page 5, penultimate lines where it is stated that "It is unlikely Gardener's system will require external charging, even if the vehicle is driven primarily in the urban environment".


In complete contrast, Lynch is a limited range mission oriented system (See Lynch at col.9, lines 38-49).

With respect to claim 59, clause (a), see Page 22, lines 1-3 of the DECISION ON APPEAL where it is stated in respect to Lynch that accelerator pedal information itself is not utilized to control the motor-generator, clause (a) further specifying a fast-charge-discharge battery for response power.

V

Claims 55 and 59 are believed clearly patentable within the meaning of 35 USC 103 and for the above reasons and evidence the final rejection on Remand should be reversed.

Respectfully submitted,


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APPENDIX A

In re Moore, 170 USPQ 260 wherein the CCPA stated at page 263:

"Again we are confronted with a set of circumstances which occurs too frequently in Patent Office appeals. In its review of the examiner's decision in this case, as noted above, the board made a ruling based not upon the facts of record which it had before it, but rather on a finding of a new fact. We recognize the right of the board, under the statute and rules, to make additional findings. We also acknowledge the technical expertise of the individual members of the board in making findings of technical fact based upon their own knowledge and experience. We have consistently sought to give weight to such findings where they do not appear unreasonable on their face and are not challenged by the applicant.

A finding such as was made here, however, supporting as it does an alternative ground for sustaining the examiner's rejection, and apparently based on nothing more than a bare allegation of scientific fact, does everything but cry out for an opportunity to respond. Appellant here did respond, and challenged the board's assertion with an allegation of his own to the contrary. He supported his assertion with the affidavit opinion of an acknowledged expert in the art. Encouraged and misled, perhaps, by some language in earlier opinions of this court, the board gave little consideration to appellant's assertion. This we feel was wrong. Appellant's response here was more than mere "argument". It was a direct challenge to a finding of fact made for the first time by the board and included with it some evidence in the nature of rebuttal. Under the circumstances, it was entitled to more serious consideration. We shall so treat it.

The contrary assertion made by appellant also does not appear unreasonable to us. In the absence of any cited authority or more detailed reasoning by which we could better evaluate the position taken, we are compelled to conclude that the Barney affidavit is sufficient to rebut the assertion made by the board..."

Accordingly, the opinion of Dr. Havemann must be accepted or refuted. Since the declaration of Dr. Havemann has nowhere been refuted, it must be accepted.